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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,853	08/13/2001	Martin Melchiors	Mo-6476/LeA 34,678	8274
157	7590	06/15/2005	EXAMINER	
BAYER MATERIAL SCIENCE LLC 100 BAYER ROAD PITTSBURGH, PA 15205			SERGENT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 06/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/928,853	MELCHIORIS ET AL.	
	Examiner	Art Unit	
	Rabon Sergeant	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al. ('393) in view of EP 159117.

Blum et al. disclose water dispersible binder compositions comprising a urethane modified polyester polyol, derived from reactants that overlap those of applicants, and a blocked polyisocyanate component. See abstract and columns 3-6.

3. Though Blum et al. disclose numerous blocking agents for masking the polyisocyanate, patentees are silent regarding the use of pyrazole blocking agents. Still, the use of pyrazoles as blocking agents for polyisocyanates that are to be incorporated into aqueous compositions in masked form was known at the time of invention. This position is supported by the teachings of

EP 159117 at page 4, lines 4+. Additionally, the secondary reference discloses that a benefit of using the pyrazole blocking agents is that the deblocking temperature is significantly lower as compared to the deblocking temperature of other conventional blocking agents. Since lower deblocking temperatures require less energy input and, therefore, require less expense, the position is taken that it would have been obvious to utilize the pyrazole blocking agents within the primary reference, so as to obtain a coating system that is less expensive to apply.

4. Applicants' argument that the instant claims differ from the prior art because the prior art requires that the urethane modified polyester be aqueously dispersed prior to addition of the blocked isocyanate (crosslinking agent) is not well taken for the following reasons. Applicants' argument and declarations are not adequately representative of the prior art, because the position is maintained that the prior art does not require that the crosslinking agent be added after formation of the dispersion. Though Blum et al. disclose embodiments where the urethane modified polyester is dispersed before the blocked polyisocyanate is added, Blum et al. further disclose at column 7, lines 16-19 that the binder compositions may be prepared simply by mixing components a), b), and c); given the description of these components within the reference, it appears clear that water is not a required component of any of components a), b), or c). Furthermore, applicants' attention is directed to the aforementioned text at column 7, lines 16-19. The text reads, "The binder compositions according to the invention or aqueous dispersions prepared therefrom may be prepared simply by mixing the individual components a), b) and c)." The language, "or aqueous dispersions prepared therefrom", clearly indicates that the language, "the binder compositions", refers to undispersed compositions that comprise components a), b)

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and c). No other interpretation of the language is reasonable. Therefore, despite applicants' response, it cannot be said that Blum et al. require that the crosslinker be added after formation of the aqueous dispersion, and for this reason, it is not seen that applicants' claims are distinguished from the prior art in the manner argued by applicants.

5. Lastly, the 37 CFR 1.132 declaration of March 21, 2005 has been considered; however, despite applicants' arguments, it is unclear what the declaration is attempting to show. Neither example of the declaration demonstrates the argued criticality of forming the dispersion after addition of the claimed blocked isocyanate. Example II does not utilize the claimed blocking agent; therefore, the relevance of the example is unclear. Example III merely demonstrates the formation of a dispersion; it does not establish the criticality of the steps in producing the dispersion. In other words, no comparative example has been provided that demonstrates that addition of the blocked isocyanate of the invention after formation of the dispersion yields an unsatisfactory result.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
June 12, 2005


RABON SERGENT
PRIMARY EXAMINER